

7833
09/181,151
Art Unit 2743

conference utilizes a sub-channel of said communication channel.

8. Method according to claim 2, wherein the audio-video conference utilizes a communication channel, and the audio conference utilizes a sub-channel of said communication channel.

A
9. Method according to claim 1, wherein the live video conference utilizes a relatively high-bandwidth communication channel, and the audio-only conference utilizes a POTS channel, of relatively lower bandwidth.

10. Method according to claim 2, wherein the audio-video conference utilizes a relatively high bandwidth communication channel, and the audio conference utilizes a relatively low bandwidth POTS channel.

REMARKS

This Amendment is submitted in response to the Office Action mailed on April 7, 2000. Claims 1 - 4 are pending, and all stand rejected at present.

Dependent claims 5 - 10 are added. No fee is due. Support for the added claims can be found at the following locations, and others.

7833
09/181,151
Art Unit 2743

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Added Claim	Location of Support
5	Figures 1 and 2.
6	Page 7, "Additional Consideration Number 1."
7, 8	Fifth paragraph of "Detailed Description of Invention."
9, 10	Page 7, "Additional Consideration Number 1."

Summary of Response

Invention

Setting up a video conference takes time. Under the invention, the parties to the conference begin with an ordinary telephone conference, but accompanied by a display of "canned" still pictures of the parties, which is generated by a computer. While the parties talk, the invention sets up the video conference. Then, when the video conference becomes finally set up, the ordinary telephone conference is terminated, and the video conference proceeds.

Kafuku Reference

Applicant has sworn behind Kafuku. This removes the basis for rejection to claims 1, 3, and 4.

Schneider Reference

Claim 2 cannot be obvious, based on Schneider, because Schneider teaches directly away. Claim 2(c)(ii) recites termination of the audio conference, after the video conference sets up. Schneider expressly states that his POTS call may continue, while the video conference proceeds. So even if a POTS call is used to assist in set-up, as the Office Action asserts, Schneider states that the POTS call may continue, contrary to claim 2, which states that it terminates.

Further, the PTO combines Schneider with "well known" prior art. Even if that is done, claim 2 is not attained: three elements of claim 2(b) are missing.

-- The combination equips Schneider with "audio conferencing." However, claim 2(b) recites that an audio conference is **actually held**, not that such a conference is **available**.

The Schneider-combination merely states that an audio conference is **available**.

-- Claim 2 states that the audio conference is held **during set-up of a video conference**. Again, the combination merely states that an audio conference is **available**, not that it is used, nor **when** it is used.

-- Claim 2 states that the audio conference

7833
09/181,151
Art Unit 2743

uses a POTS (Plain Old Telephone Service) line. Again, the combination merely states that an audio conference is **available**, not that POTS lines are used.

Further still, no teaching has been given for combining Schneider with the "well known" prior art. The rationale for the combination is that the "well known" prior art reduces set-up time for Schneider's video call.

However, that rationale is dubious: it is a naked conclusion, unsupported by evidence.

Further, the validity of the rationale is highly suspect. Schneider sets up a video call using ISDN telephone lines (for example). How could the mere presence of an "audio conference" possibly speed up the process of setting up an ISDN connection ?

Still further, the combination re-designs Schneider, contrary to the MPEP. Schneider shows an initial POTS call: it is a data call, requesting a video conference. The combination eliminates that data call, and replaces it with the "audio conferencing," which supposedly speeds up the set-up operation.

With that substitution, Schneider is now **inoperative**: no data call exists to request the video conference.

End of Summary

7833
09/181,151
Art Unit 2743

Response to 102 - Rejections

In response to the anticipation rejection of claims 1, 3, and 4, based on Kafuku, Applicant points out that the statute used seems to be incorrect. The rejection is based on section 102(e). However, the only relevant part of that section states that the rejection must be based on an "international application."

But that term does not refer merely to an application of another country, but to international applications **within the U.S. Patent Office.**

That is, the relevant part of section 102(e) refers to "international applications" within the USPTO, which comply with 35 USC 371. No evidence has been cited showing that Kafuku has achieved such compliance.

Therefore, it appears that Kafuku is available only as a "printed publication." Such references are available under other sections, perhaps section 102(a).

As a "printed publication," the publication date of Kafuku is August 7, 1998. Applicant's filing date is in October, 1998, a little over two months later. The undersigned attorney, as representative of the Assignee, submits a Declaration under 37 CFR § 1.131, showing conception prior to the publication date of Kafuku.

Therefore, Applicant submits that the rejection based on Kafuku should be withdrawn.

7833
09/181,151
Art Unit 2743

Response to 103 - Rejection

Claim 2 was rejected as obvious, based on Schneider.¹ Claim 2 recites:

2. A method of establishing an audio-video conference, comprising the following steps:

- a) setting up an audio-video conference on a high-bandwidth communication channel;
- b) during the setting-up step, holding an audio conference using a POTS channel; and
- c) after setting up completes
 - i) holding the audio-video conference on the high-bandwidth channel; and
 - ii) terminating the audio conference on the POTS channel.

In response, Applicant points out that Schneider does not show claim 2(b).

Schneider Reference

Schneider's Background discusses ordinary ACDs, Automated Call Distribution systems. As a simple example of an ACD, assume that ten people work in an office. A central, automated,

¹ It is assumed that the "1" in the phrase "Regarding claim 1" in section 6, second paragraph 2, of the Office Action is a mistake. If not, this response applies to claim 1 as well.

7833
09/181,151
Art Unit 2743

switchboard receives incoming telephone (not video) calls. The switchboard identifies an employee whose telephone is not busy, and routes the incoming call to that employee.

However, this type of routing of **telephone calls** cannot be extended to **video** calls, at least not in a simple, inexpensive manner.

Schneider's solution is "video call back." A caller, who wishes a video conference, causes a computer program to place a "data call," using the ordinary POTS telephone system. (Column 2, line 31.) Schneider's ACD receives the POTS call. Four factors are significant here:

1. A computer places the call. (Column 2, lines 28 - 31.)
2. The call is a "data" call, containing a message. (Column 2, lines 28 - 31.)
3. The caller does not speak to the called party, although a recorded message may be delivered to the called party. (Column 4, line 46.) Thus, no "audio conference" exists.
4. The ACD locates a "free agent," and delivers the message to the free agent's computer. (Column 2, lines 34 - 42.)

The message contains the caller's telephone number. The free agent's computer places a video call to that telephone number.

7833
09/181,151
Art Unit 2743

(Column 3, lines 14 - 23.)

Therefore, a caller's computer transmits a message, via a POTS call, to an ACD. The ACD routes the message to a recipient's computer. The recipient's computer, in response, places **A RETURN CALL**, namely, a high-bandwidth, video call, to the caller, in order to hold a video conference.

This procedure effectively accomplishes routing of a video call, but indirectly. After the incoming call occurs, a video conference is held.

Claim 2(b)

Claim 2(b) recites

b) during the setting-up step, holding an audio conference using a POTS channel.

That step is not found in Schneider. Schneider, column 3, lines 35 - 67, states that the initial POTS call may be maintained during the video conference, for two reasons. One reason is that maintaining the call ties up the free agent's telephone line, thereby indicating that the free agent is busy (with the video conference). Consequently, the ACD will not route additional calls to the free agent.

A second reason is that monitoring equipment is sometimes maintained by the ACDs. The monitoring equipment logs, for

7833
09/181,151
Art Unit 2743

example, for each call, the agent who handled it, and the duration of the call. Under the invention, the POTS call induces the ensuing video call. Once the video call is placed, the POTS call can be terminated.

However, the POTS call will be very short. But that shortness does not accurately reflect the activity of the free agent, who is then occupied with the video call. That is, merely logging of the short POTS call would be misleading: the POTS call is merely a precursor to a longer video call, which is not logged by the monitoring equipment, because the equipment monitors the ACD, not the video call.

Therefore, if, instead, the POTS call is maintained during the video call, the monitoring equipment will detect a lengthy POTS call, which accurately reflects the activity of the free agent. This is the second reason for maintaining the POTS call, after the video conference is set up.

However, the POTS line is **idle** during the video conference. Schneider states:

Maintaining the initial POTS call, **EVEN THOUGH NO INFORMATION IS TRANSFERRED**, acts as a signal to the ACD . . .

(Column 3, lines 46 - 47.)

Claim 2(b) recites

7833
09/181,151
Art Unit 2743

b) during the setting-up step, holding an audio conference using a POTS channel."

Schneider's maintenance of the POTS call is not "holding an audio conference." As just stated, "no information is transferred."

Further, the call is a **data** call. The caller's computer delivers a message to the free agent's computer. That is not an "audio conference," as in claim 2(b). Further, Schneider, column 7, lines 55 - 59, states:

. . . the MESSAGE of FIG. 2 is not analogous to an audio telephone message which a person leaves on a telephone answering machine. The MESSAGE . . . contains digital data, which is unintelligible to the human ear.

Further still, the mere fact that a POTS line is involved does not raise the implication that the call is an "audio conference." POTS lines are commonly used to carry data, and Schneider states that programmable modems can be used to carry the POTS call. (Column 2, bottom.)

Still further, Schneider states that the POTS call, and setting up the video call, is placed "without human intervention." (Column 2, line 63.) Thus, no reason exists to assume that the POTS call, if maintained during the video conference, is used to "hold an audio conference."

Therefore, claim 2(b) is not shown in Schneider.

7833
09/181,151
Art Unit 2743

re: "Well Known" Art

The Office Action, bottom of page 3, admits that Schneider "does not explicitly teach audio exchange during the POTS call." The Office Action takes Official Notice of the existence of "audio conferencing," and combines the noticed "audio conferencing" with Schneider.

However, the term "audio conferencing" can possess multiple different meanings. For example, if I purchase a hamburger from a drive-through window at a fast-food restaurant, I engage in "audio conferencing." But claim 2 does not read on that type of "audio conferencing." If that type of "audio conferencing" is combined with Schneider, claim 2 is not attained.

Therefore, Applicant traverses this assertion, and requests that a reference be cited showing "audio conferencing." (See MPEP § 2144.03.)

Further, the practice of citing "well known" art, if properly done, merely removes the need to cite prior art to show a claim element. The element's existence becomes presumed. However, a teaching for combining the "well known" art with Schneider is still required. But no such teaching has been given.

The rationale for combining the references is that the combination "facilitate[s] quicker means to set up . . . [Schneider's] video conference call." However, several problems exist with this rationale.

Problem 1

One is that the rationale asserts that a "quicker means" is provided by the combination of references, but that "means" has not been identified. That is, the rationale asserts that (1) a certain element, namely, the "quicker means" is obtained by the combination of references, and (2) this "means" reduces the set-up time in Schneider. But if the "means" is not identified, then no evidence has been given that the set-up time is actually reduced.

Problem 2

A second problem is related to the first. The rationale has not actually shown how addition of the "audio conferencing" will reduce Schneider's set-up time.

Moreover, the attainment of any such reduction is highly dubious. Schneider sets up a video call by establishing, for example, an ISDN telephone link. (Column 4, bottom.) Applicant requests an explanation of how the presence of "audio conferencing" can speed up the establishment of such a link.

Problem 3

A third problem is that the addition of "audio conferencing" to Schneider acts as a modification of Schneider. MPEP § 2143.01, last paragraph, states:

7833
09/181,151
Art Unit 2743

If the proposed modification or combination of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.

Problem 4

A fourth problem is that the rationale modifies Schneider to "provide for audio conference." (Page 4, top.) Even if that is done, and even if a teaching is found to do it, claim 2 is still not attained. Claim 2(b) contains several recitations:

- 1) "holding an audio conference;"
- 2) the "holding" is done "during the setting up step;" and
- 3) the "audio conference" is held "using a POTS channel."

As to (1), the Office Action's combination "provide[s] for audio conference." But **providing** for an audio conference does not imply that an audio conference is **actually held**. "Providing" merely means that equipment for the conference is available, if desired. In contrast, claim 2(b) states that the audio conference is **actually held**.

As to (2), the Office Action's combination does not show holding the conference "during the setting up step." The combination merely has a conference available.

7833
09/181,151
Art Unit 2743

Further, holding the conference during Schneider's set up would make no sense. Why would the free agent in Schneider make an ordinary telephone call to the caller, when a video conference is just about to start ?

As to (3), the Office Action's combination has not shown that the "audio conference" is done using a POTS channel.

Therefore, even if the Office Action's combination is valid, which is not the case, three recitations of claim 2(b) are absent. MPEP 2143.03 states:

To establish prima facie obviousness . . . all the claim limitations must be taught or suggested by the prior art.

Other Recitations Absent from Combination

In addition, the combination fails to show other recitations of claim 2. Claim 2(c) recites:

. . . after setting up completes
ii) terminating the audio conference on the
POTS channel.

No such termination has been shown in the PTO's combination.

Therefore, several of the recitations of claim 2 are absent from the PTO's combination of references. Under these circumstances, the rejection cannot stand.

7833
09/181,151
Art Unit 2743

Another Problem

In addition, another fundamental flaw exists in the rejection. Claim 2(c) recites terminating the POTS call after setting-up of the video call is complete. Schneider expressly states that the initial POTS call may continue during the video conference. (Column 3, line 35 et seq.)

Therefore, Schneider's teaching is **directly contrary** to this recitation of claim 2. Schneider cannot be used to support the rejection. MPEP § 2111 states:

PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY,
INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE
CLAIMS

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

Combination Renders Schneider Inoperative

The party in Schneider wishing a video conference causes its computer to place a POTS call, which delivers a message. (Column 2, lines 28 - 34.) The combination of references replaces that POTS call with the supposedly "well known" "audio conferencing."

However, after the combination, Schneider is now **inoperative**: how does the message now reach the ACD ?

MPEP § 2143.01, section 5, states:

7833
09/181,151
Art Unit 2743

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

Abstract

An Abstract of the Disclosure is herewith submitted.

Conclusions

Applicant submits that the Kafuku reference is not available as prior art.

Applicant submits that, as to the obviousness rejection based on Schneider:

- Even if the references are combined, three recitations of claim 2(b) are absent, and claim 2(c)(ii) is absent also;
- No teaching has been given for combining the references;
- The rationale for the combination is that set-up time in Schneider is reduced, but no explanation is given of how that reduction is attained, and whether such attainment actually occurs is dubious;
- Schneider teaches directly away from claim 2(c)(ii); and
- The combination renders Schneider

7833
09/181,151
Art Unit 2743

inoperative.

Any one of the preceding is sufficient to preclude the obviousness rejection.

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,



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ATTACHMENTS: (1) Rule 131 Declaration,
including prior draft
of application, and
(2) Abstract.